

## **REMARKS**

In response to the Office Action dated August 17, 2010, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-4, 6-15, and 18-38 are pending in this application.

### **Double Patenting Rejection**

The Office provisionally rejected the pending claims for obvious-type double patenting over claims 1-20 of co-pending U.S. Application 11/212,370 (Attorney Docket 01372 CIP). Should either application receive a Notice of Allowance, the Assignee will promptly consider a terminal disclaimer.

### **Rejection of Claims under § 103 (a)**

The Office rejected claims 1-4, 6-15, and 18-38 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2002/0049631 to Williams in view of WO 99/45702 to Knudsen.

This rejection, though, is erroneous. The Office has, very respectfully, misinterpreted the teachings of *Williams* with *Knudsen*. When *Williams* and *Knudsen* are correctly interpreted, the pending claims cannot be obvious.

*Williams* discusses an incentive system that associates incentives to purchased items. *See, e.g.*, U.S. Patent Application Publication 2002/0049631 to Williams at paragraphs [0012], [0013], and [0033]. A database stores “prerequisites” for incentives. *See id.* at [0020]. *Williams* discusses a set top box that can send “an acceptance of an offer” in “instructions” to an advertisement. *See id.* at [0035] - [0037]. Purchase data is received from point-of-sale terminals and compared to the “prerequisites” for the incentives. *See id.* at [0020], [0033], and [0041].

*Knudsen* describes how tags may be added to advertising and programming. An “advertisement for athletic footwear,” for example, may include a “channel tag” that includes “channel identifier information” for sports channels. *See* WO 99/45702 to *Knudsen* at page 29, lines 18-22 (emphasis added). “Broadcast time tags” identify broadcast times, such that “advertisements for breakfast foods” are associated with “morning time slots” and “dinner foods” are associated with “evening” hours. *Knudsen*, at page 29, lines 22-28 (emphasis added). “Category tags” relate to “genres or themes,” such that the “advertisement for athletic footwear” may be associated with “sports.” *See id.* (emphasis added).

The Office contends that the independent claims are obvious over *Williams* and *Knudsen*. The Office, in particular, contends that *Williams* with *Knudsen* teaches “*receiving content information describing content selections by a user*,” and the Office specifically cites to *Williams*’s paragraph [0035], which is reproduced below:

[0035] The IIS 50 may also operate with systems that allow viewers of television advertisements to respond by either by using a calling a toll free telephone number or by sending an acceptance of an offer as a transmission from digital set-top box having the capability to transmit information. A television advertisement may instruct viewers to call a toll free telephone number in order to provide identification information which will be used to store the electronic incentive electronic incentive in association with the identification. A digital set-top box may be used in television systems that support bi-directional communication to a central location with an IIS facility. The digital set top box allows the viewer of a television advertisement to select and send responses to the central location, and ultimately to the IIS, in response to instructions given on the television advertisement. The digital set-top box may be programmed to store customer identification information, thereby obviating the requirement for the television user to enter the information, or the digital set top box may support entry of identification information. In this way, a customer may select, for example, incentives via the Internet or T.V. and receive a credit at the retail store 30 when he or she makes the required purchase.

Here *Williams* explains that a set top box may send an acceptance of an offer. A television advertisement may contain instructions, and the set top box may send a response. *Williams*’s paragraph [0035], though, is silent to “*receiving content information describing content*

*selections by a user,”* as the independent claims similarly recite. The only reasonable conclusion is that *Williams* sends “responses” to advertisements. *Williams’s* paragraph [0035], though, is wholly silent to “*receiving content information describing content selections by a user.*” For this reason alone, then, the independent claims cannot be obvious.

The independent claims recite even more distinguishing features. Independent claim 1, for example, recites “*comparing the data describing the event timeline to the credit card purchase records.*” Examiner Alvarez again contends that *Williams* with *Knudsen* teaches these features, and Examiner Alvarez specifically cites to *Williams’s* ability to “monitor purchases over a period of time.” *See* Examiner Alvarez, Office Action mailed August 20, 2010, at page 3, paragraph 5, lines 10-11. The proposed combination of *Williams* with *Knudsen* describes a database that stores incentives, and purchase data is received from point-of-sale terminals. *See Williams*, at [0020], [0033], and [0041]. The mere receipt of purchase data, though, is not reasonably equivalent to “*comparing the data describing the event timeline to the credit card purchase records.*” Even if *Williams* with *Knudsen* receives purchase data from point-of-sale terminals, *Williams* with *Knudsen* completely fails to compare this purchase data to the claimed “*event timeline.*” The proposed combination of *Williams* with *Knudsen* compares purchase data to prerequisites for incentives. *See Williams*, at [0020]. The independent claims, in contradistinction, “*compar[e] the data describing the event timeline to the credit card purchase records.*” The proposed combination of *Williams* with *Knudsen* simply fails to teach or suggest these features. Any other conclusion is unreasonable.

The independent claims recite more distinguishing features. Independent claim 1, for example, also recites “*receiving clickstream data describing commands entered by the user while viewing the content selections.*” Examiner Alvarez again contends that *Williams* with *Knudsen* teaches these features, and Examiner Alvarez specifically cites to *Williams’s* paragraphs [0029] and [0035], which are reproduced below:

[0029] Accordingly, the present invention transcends the single retail store and single retail store chain electronic incentive concept and automatically provides the capability to offer and process cross-chain or cross-industry electronic incentives. **The present invention, as will be**

described with respect to FIGS. 1-3, provides a system that offers customers incentives through the Internet, T.V. broadcasts, direct mail, etc., while the customer is at home, in a store or elsewhere and then allows that customer to automatically receive the benefit of the incentive at their choice of retailer, which choice may include conventional retail stores or Internet retail facilities.

[0035] The IIS 50 may also operate with systems that allow viewers of television advertisements to respond by either by using a calling a toll free telephone number or by sending an acceptance of an offer as a transmission from digital set-top box having the capability to transmit information. A television advertisement may instruct viewers to call a toll free telephone number in order to provide identification information which will be used to store the electronic incentive electronic incentive in association with the identification. A digital set-top box may be used in television systems that support bi-directional communication to a central location with an IIS facility. The digital set top box allows the viewer of a television advertisement to select and send responses to the central location, and ultimately to the IIS, in response to instructions given on the television advertisement. The digital set-top box may be programmed to store customer identification information, thereby obviating the requirement for the television user to enter the information, or the digital set top box may support entry of identification information. In this way, a customer may select, for example, incentives via the Internet or T.V. and receive a credit at the retail store 30 when he or she makes the required purchase.

Here *Williams* explains that incentives may be offered through the Internet, and a set top box may send an acceptance of an offer. Examiner Alvarez, though, argues that these paragraphs are equivalent to “*receiving clickstream data describing commands entered by the user while viewing the content selections.*” Examiner Alvarez, in particular, argues that the mere mention of “online” makes it obvious to “*merg[e] ... the clickstream data with the content information to generate data describing an event timeline that describes the clickstream data and the content information over time.*” See Examiner Alvarez, Office Action mailed August 20, 2010, at page 4, lines 4-13. Examiner Alvarez’s reasoning, though, is not supported by the evidence. Even though *Williams* explains that incentives may be offered through the Internet, this meager teaching cannot be reasonably interpreted as “*merging ... the clickstream data with the content information to generate data describing an event timeline that describes the clickstream data*

*and the content information over time.”* The proposed combination of *Williams* with *Knudsen* simply fails to teach or suggest these features. Any other conclusion is unreasonable.

The independent claims, then, are not obvious over *Williams* and *Knudsen*. The proposed combination of *Williams* and *Knudsen* receives purchase data and compares the purchase data to “prerequisites” for incentives. *Williams* and *Knudsen* also associates tags to advertisements. Still, though, *Williams* and *Knudsen* fails to reasonably teach or suggest many of the features recited by the independent claims. One of ordinary skill in the art, then, would not think that the independent claims are obvious.

Claims 1-4, 6-15, and 18-38, then, are not obvious over *Williams* with *Knudsen*. The independent claims recite many features that are not disclosed or suggested by *Williams* with *Knudsen*. Their respective dependent claims incorporate these same features and recite additional features. One of ordinary skill in the art, then, would not think that claims 1-6, 6-15, and 18-38 are obvious. The Office must remove the § 103 (a) rejection of these claims.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

**37 C.F.R. § 1.8 CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being electronically transmitted via the USPTO EFS web interface on November 22, 2010.



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